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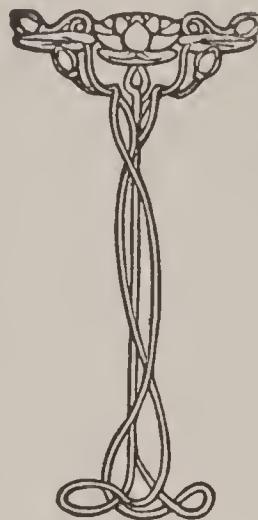


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WASHINGTON, D. C.

How to Select Trade-Marks



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How to Select Trade Marks

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PREFACE

Trade-mark owners have neglected to exercise the same care in regard to their trade-mark property, that they do respecting other property, and this is true even in many cases where their trade-mark property is of greater value than any other property which they have.

One who buys real estate demands an abstract of title thereof, and a warranty deed, and not satisfied with this, submits both the deed and abstract to a capable attorney for an opinion as to whether there is any defect in the title of the grantor. Perhaps this same person would adopt a trade-mark for use in his business without making any inquiry as to whether the trade-mark is already in use and is the property of some competitor, and without making any inquiry from any one skilled in the trade-mark law, to ascertain whether

for any reason, the thing which he has attempted to use as a trade-mark is a proper trade-mark from a legal stand-point, or whether, if he spends his money upon this trade-mark he will be entitled to the exclusive use of it as against any competitor.

In order to assist merchants and manufacturers to understand more fully the laws of the United States, pertaining to trade-marks, I have set forth under several sub-heads, the important matters which most frequently confuse trade-mark owners; and often a failure to understand the principles of law treated under these sub-heads, and the failure of the party to take advice from a competent adviser, results in great loss.

HOW TO SELECT TRADE-MARKS



DESCRIPTIVE TRADE-MARKS

The manufacturer or merchant intends to build a business and good-will on the name of the goods he makes or sells, and the selection of that name is a very important matter. People who buy goods are inclined to give them a name and it is easy for the customer to ask for what he wants if he can give it a name. Oysters is a general name for a food product, but a dealer in oysters who was very enterprising and desired people to know his oysters from others, called them "SEAL SHIPPED." They were shipped sealed. Other people had a right to ship oysters sealed and say they were seal shipped oysters. A customer asks for seal shipped oysters and he gets them of the dealer, but

they are not the oysters packed by the one who uses the word, "SEAL SHIPPED" as a trade-mark for oysters. The mistake in selecting this trade-mark no doubt cost the company thousands of dollars.

People have a right to make gum and flavor it with spearmint. Wrigley did so. He then named the gum what it is, "Spearmint." One who goes into a drug store where chewing gum is sold, and examines the packages can see for himself how many "Spearmint" packages there are, and how closely they resemble the original "WRIGLEY SPEARMINT" and will see how easy it is to imitate a descriptive mark. It is one which compels the owner to resort to expensive litigation to protect himself against fraud, under the law of unfair competition. I give here a number of illustrations of trade-marks which have been held descriptive, but where the owner has obtained some relief from fraudulent practice of others. A judgment against fraud in such cases is very useful and yet the

path of the owner of such a trade-mark is always strewn with thorns and it is unwise to use as trade-marks, descriptive words. The following are a few of the thousands of descriptive trade-marks:

PEPSIN PUNCH—For non-alcoholic beverage.

FELTLESS—For sweat pads.

PAIN-EASE—For medicine.

FULLCUT—For clothing.

CLUB-HOUSE—For gin.

STRAIGHT-CUT—For cigarettes.

ELASTIC—For suspenders.

IRON BITTERS—For medicine.

HEALTH-FOOD—For food product.

ALUMINUM—For wash boards.

FAVORITE—For letter file.

COMPUTING—For scales.

STERLING—For ale.

SPEARMINT—For chewing gum.

STANDARD—For any goods.

MISSPELLED DESCRIPTIVE WORDS

A great many business men seem to believe that to misspell a descriptive word takes out its descriptive character,

and such words as "KLEANWELL," "BESTOFA LL," "NEVERS-TICK," "FINEETING, FITS-U," are a few of the illustrations of such words which have been held to be descriptive of the goods and not valid trade-marks.

GEOGRAPHICAL NAMES

In adopting a new trade-mark, it should be ascertained whether it is the name of any Country, State, City, Town, County, River, Bay, or other geographical name and if it has no important meaning other than being a geographical name, it should be discarded and another name selected. Geographical names may sometimes be protected under the law of unfair competition. The Elgin National Watch Company has expended large sums and fought many law suits in trying to protect the word "ELGIN," as a trade-mark for watches. A few of the numerous geographical trade-marks are the following: "MOBILE; YALE; OZARK; MANHATTAN; CONTINENTAL; ORIENTAL; UNION; AKRON,

for cement; LACKAWANNA, for coal; MOLINE, for plows; COLUMBIA, for flour; ELGIN, for watches; OLD COUNTRY, CADILLAC and TABASCO." Some geographical names have other very important meanings than being the name of a town, city or place, such as "DEFIANCE," and are proper trade-marks, but it is unwise to adopt a new trade-mark of that nature because there is always the possibility of some one in that town or city engaging in the same business in which the owner of the trade-mark is engaged, and there is no way to prevent the use of the name of the town provided it is honestly used by a citizen thereof.

FOREIGN WORDS

Foreign geographical terms are subject to the same objection that is made to geographical terms referring to places or things in America. Words that are descriptive of the goods in a foreign language are rejected for the same reason given in cases of Eng-

lish descriptive words. In a recent case prosecuted by the author before the Commissioner of Patents, even "ESPERANTO" was recognized as a language to such an extent that the word "SANIGA," which is the Esperanto word for sanitary, for mattresses was rejected because of its descriptive character. A few illustrations of descriptive words in a foreign language are the following: "LE-BON," meaning "The Good;" "BRASSIERE," a French word for brace as applied to an article of women's wear; "CONSERVA DI TOMATE," being Italian for preserved tomatoes.

In adopting a new trade-mark avoid words of a foreign language that are descriptive of the goods or any characteristic of the goods; also avoid foreign geographical terms.

DECEPTIVE TRADE-MARKS

A trade-mark which is deceptive or contains a deceptive suggestion, cannot be exclusively appropriated. The word, "HALF SPANISH," applied to cigars

where the tobacco contained therein is not half Spanish, is held to be deceptive if the tobacco is not half Spanish and if it is half Spanish it is descriptive. "SYRUP OF FIGS," a preparation which contains very little, if any, syrup of figs, is held to be deceptive.

COLORS AS TRADE-MARKS

Mere colors are not proper trademarks, but a color placed at some particular spot on the goods, not necessary in any sense for ornament, or preservation of the material, being wholly arbitrary, may be upheld.

REGISTRATIONS PROHIBITED

AMENDMENTS OF THE UNITED STATES TRADE-MARK LAW

Under the federal trade-mark act and its amendments, the following are prohibited:

1. Immoral or scandalous matter.
2. Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof,

or of any state or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, *or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any state in the United States prior to the date of the adoption and use by the applicant.* Provided, That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant: Provided, that trademarks which are identical with a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the

public or to deceive purchasers shall not be registered: Provided, that no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this act: Provided further, That no portrait of a living individual may be registered as a trade-mark except by the consent of such individual, evidenced by an instrument in writing: And provided further, That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several states or with Indian tribes, which was in actual and exclusive use as a trade-mark of the applicant, or his pred-

ecessors from whom he derived title, for ten years next preceding February 20th, 1905: Provided further, That nothing herein shall prevent the registration of a trade-mark otherwise registrable because of its being the name of the applicant or a portion thereof.

Approved, January 8, 1913.

(The new provisions are in italics.)

3. It is unlawful to use the red cross for purposes of trade or advertisement unless the use began prior to January 5, 1905. (Penalty, fine and imprisonment.)

REGISTERING UNDER THE TEN-YEAR CLAUSE

There is a provision in the registration act of 1905, to the effect that if a person can show that he has been the *sole* and *exclusive* user of a word as a trade-mark from February 20, 1895, to February 20, 1905, he can register it, even if it is a geographical name, a descriptive name, or the name of a person.

A number of decisions have been handed down on this provision and the last one by the U. S. Circuit Court of Appeals practically nullifies any advantage intended to be given a mark of this kind. Such registration, however, serves as a basis for foreign registrations.

INFRINGEMENTS AND SIMILARITY

Is the word or trade-mark you are about to adopt like or similar to one that is in use by any other person or concern manufacturing similar goods? Whether one trade-mark is similar to another, is a question of opinion based on observation and sometimes on evidence showing that purchasers have mistaken one for the other. The Federal Courts have, in a number of decisions, in important cases, established certain rules by which one may be guided to a certain extent, in determining whether one trade-mark is similar to another.

After you have established a large business, expended thousands of dollars for labels, advertised your trade-mark in magazines, on sign-boards, and in various other ways, it would be a great calamity to your business if some rival concern would file a suit in the United States Court and enjoin you from using your trade-mark in the sale of your goods, or putting the name on your goods, or from putting the name on advertising matter, or publishing it in newspapers and magazines. In recent years numerous suits of this character have been successfully prosecuted in Federal and State Courts, and the number of cases litigated are rapidly increasing.

To avoid trespassing on the rights of others in adopting a new trade-mark is one of the most difficult problems to solve. There is no place where all trade-marks are recorded and consequently no way of being certain that you are not adopting one already in use. You should learn from a trade-mark attorney what is on file in the

patent office. There are a very few lawyers giving special attention to this subject, but those who are, have sources of information as to unregistered trade-marks and it is therefore important to consult some one who has an extensive practice in this line. The following trade-marks have been held to be similar:

Autogirdle and Auto-Garter; Auto-piano and Piano-Auto; Autola and Auto-do; Akroma and Armona; Benedictine and St. Benedict; Colonial and Colonial Dame; Celluloid and Cellonite; Cottoleo and Cottolene; Cascarets and Castorets; Comfort and Home Comfort; Ceresota and Cressota; Croupine, Kroupol and Crouplene, Carbolineum and Creo-Carbolin; Diamond Dust, Diamond and Diamond Mills; Edelweiss-Maltine and Maltine; Eagle and Gold Eagle; French and French Opera; Hoff's and Leopold Hoff's; Keepclean and Stakleen; Knoxall and Beats-All; La Vona and Larona; Mayfield and Mayfair; Maploma and Mapleine; National and New National; Nitro Hunter and Nitro;

Optine and Optal Optimates and Optimo; Pepko and Pep-Kola; Remington and Remington Shoals; Soda Foam and Sea Foam; Satin and Satin Skin; Sapolio and Sapho; Vital Ore and Vitalizing Ore; Yusea and U-C-A; American Lady and American Girl; Auburn Lynn and Auburn Lynn Shoe Co.; Crystal Lake, Crystal Glen and Crystal Run; Charter Oak, Old Charter and Royal Charter; Chancellor Club and Club Cocktails; Don Carlos and Don Caesar; Diamond Jo, Diamond Mills and Big Diamond; Gold Dust and Cold Drop; Georgia Coon and New Coon; Ladylike and Lady Lee Shoe; Old Dutch Blend and Royal Dutch; Walnut Hill and Walnut Creek.

YOUR OWN NAME AS A TRADE-MARK

Ordinarily any person has a right to use his own name on his goods and very often the builders of business desire to make themselves famous in the business world by using their names as trade-marks on everything they sell. They never think that there are other

people of the same name who may make or sell the same kind of goods and may take advantage of the extensive advertising of his name to make large profits for himself with comparatively little expense for advertising. It is true that the law of unfair competition may to some extent protect the one first in the field, but such protection is not always satisfactory and it is not good business policy to use the name of a person for a trade-mark. You can not register it in the United States Patent Office unless it comes within the ten-year proviso of the trade-mark act, or is written in a distinctive form, or is associated with the portrait of such person.

In export trade it is highly important to register all trade-marks in the countries where trade is carried on. In many foreign countries the first to register a trade-mark is the owner. Some of them will permit registration by a citizen of a foreign country only in cases where he has first registered his trade-mark in his own country, and if you are barred from the United

States Patent Office, you are likewise barred from such other countries.

A personal name is usually productive of expensive litigation. Let us remember a few of them. L. E. Waterman Co. vs. Modern Pen Co., 183 Fed pp. 118. The court after long litigation decided the defendant should place near the name "Waterman," the phrase, "Not connected with the original Waterman Pens."

In Walter Baker & Co., Ltd., vs. Grey et al., 192 Fed. pp. 921, it was held that all equity requires is that a person shall make an honest use of his name and when that is done, a dealer in two articles need not affirmatively warn a customer ordering goods by means of a surname, that there are two makers of that name, and inquire whose product is desired. The suit was dismissed.

In McLean vs. Fleming, 96 U. S. pp. 245, the controversy was over Dr. McLean's Liver Pills and Dr. McLean's Universal Pills.

In Singer Mfg. Co. Vs. June Mfg. Co.,

163 U. S. 169, the controversy was over the right to use the name "Singer" in the sale of sewing machines. An injunction was granted not so much because of the manner of using the name, as for various other acts in making the machines look the same. No injunction was granted against use of the name "Singer" if accompanied with explanation that it is not the original Singer Co.

In the decisions will be found hundreds of cases concerning the right to personal names.

Names distinctively written are proper trade-marks, such as a signature, but purchasers do not ask for William's Soap with the name written in the handwriting of "John Williams," but simply ask for William's Soap. The exclusive right to use a name written in a distinctive manner is not worth much in practice, for the reason that it is the manner of writing it that constitutes the trade-mark and not the name.

Names of ex-presidents. The Commis-

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sioner of Patents refuses to register as trade-marks the names of ex-presidents of United States. The refusal is on the ground that it is against public policy to permit the use of such trade-marks.

LABELS

Are your labels designed by a label or printing house who sells the same design to your competitors? If such is the case, you can have no exclusive right to that label even if it contains what would have been a technical trade-mark if you had originated it and first applied it to the goods. If your label is so similar to the label of your competitor who adopted and used his label earlier than you did yours, as would likely confuse purchasers, your competitor can prevent your use of the same in a manner calculated to deceive purchasers. Stock labels are those designed by a label house and sold to various parties for use in the same business and one user has no more right to it than another. Every merchant should be original or hire some one to

be original for him in designing matter to put on his package. A label makes up the "dress" of the package and may be protected against infringement, if a competitor simulates it in a way which would likely deceive purchasers.

FALSE STATEMENTS ON LABELS

A court of equity will not protect a trade-mark or package of one who puts false statements of material facts on his labels, and a party who desires to appeal to a court for protection must see that his good will is not constructed on false and misleading statements to induce people to buy his goods. No statement should be put on a label which can not be proven to be true. I quote from a decision in the 152 Fed. 498, the following:

"There is no hardship in requiring a complainant who has stated certain things to the public as truths in order to promote the sale of his goods, to state the same things as truths to the court and prove them as truths in order to secure equitable relief."

PACKAGES

Are the packages in which you sell your goods of your own design and different from the packages of your competitors? Purchasers often learn to know the goods of a manufacturer by the peculiar or attractive package in which they are sold. Our courts have frequently sustained suits to prevent persons from dressing up their packages to look like the package of a successful rival concern who originated the package. There is a strong inclination of new concerns to imitate the style of packages of old successful concerns. Be careful to put no materially false or misleading statements on your package, for such statements are often used to bar an action against an infringer.

ACQUIRING A SECONDARY MEANING

A geographical name or descriptive name or other imperfect trade-mark may be so well known to purchasers that when they see the name in con-

nnection with the goods, think only of the maker of the goods. To illustrate, if a customer enters a jewelry store and asks for an Elgin watch, the jeweler understands that his customer desires a watch made by the original makers of the Elgin watch, and not just any watch made at Elgin, Illinois. If a purchaser asks a dealer for a Gillett razor, the dealer does not understand that his customer will be satisfied with any razor made by a man whose name is Gillett, but that he wants the particular razor made by the company who has so extensively advertised that name. When the name is so well known that both purchaser and dealer understand whose goods are wanted when the goods are called for by the name, then it has acquired a secondary meaning.

FORM OF THE ARTICLE

Courts have even sustained the right of a manufacturer to a particular form of an article where such form is a

matter of beauty and ornamentation and not essential to the usefulness and operation of the thing made. Little can be said as to general rules on this subject, for each case rests on its own foundation, and a careful investigation of the particular case would be necessary to determine whether this branch of the law would be helpful to one whose goods are being copied.

DESIGNS

The beauty of the design of an article may be the most important item in recommending it to public favor, and, though the article could not be patented as a new mechanical device, still the design might be patented. In some cases, courts have sustained the right of a manufacturer to a design even where it has not been patented. A great many manufacturers, not knowing that they have any right to a design, have permitted rivals to copy their most attractive designs and put them on the market.

MISTAKES TOO OLD TO MEND

The manufacturer knows what to do in the future in adopting new trade-marks, packages, labels and designs, but what is he to do about the descriptive trade-mark which has been advertised all over the country and on which his business is constructed. What is he to do if he has constructed his business and good will on a geographical mark? What is he to do if he has used his own name as a trade-mark or trade name and some other person of the same name begins a similar business and uses the same name as a trade-mark or trade name? The answer to each of the above questions depends upon the circumstances in each case, but wherever there is a wrong there is usually a remedy. Submit the facts to an attorney who has had a large experience in trade-mark and unfair competition cases. It will not cost any great sum to get expert advice and after your attorney furnishes you an opinion, you can form your own opinion as to taking any action against the infringer.

FOREIGN COMMERCE

Those who are doing an export business may find that some unscrupulous agent has taken advantage of the fact that in certain countries the first to register a trade-mark is the owner of it, and that he has registered the trade-mark of his principal and the real owner is prevented from using the trade-mark. Many foreign countries require citizens of the United States to first register their trade-marks in the United States before they will be registered in such other countries.

HOW TO OBTAIN INFORMATION

After a manufacturer or merchant has selected a trade-mark which he thinks he will adopt, before entering upon an expensive campaign of advertising, or procuring a large quantity of expensive labels, he should consult an attorney who has made a specialty of trade-marks and unfair competition. He will investigate all registered trade-marks and other sources of information which he has gathered along this line,

and while his opinion will not be infallible as to whether the trade-mark is being used by others, still the chances of making a mistake will be greatly lessened. The cost of making such investigation is a very small matter compared to the money that will be expended in advertising the name.

RECORD OF TITLE

The owner of real estate never neglects to put on record his deed for real estate, but very often, even if the trade-mark is registered, and a sale of the business takes place, the trade-marks are not mentioned, and, even if mentioned in the sale, no attention is given to making a formal assignment and recording it in the Patent Office. This is an important part of every transfer of a business and should not be neglected.

BUYING TRADE-MARKS

Keep in mind that a trade-mark represents the good will of a business and if there is no business, there is

no trade-mark. However, it may be necessary sometimes to go through the formality of buying a trade-mark like or similar to your own, where you find another was the first to use it. While it may not give you an earlier date of first use, still it would at least be an abandonment by the person whose trade-mark you purchase, and worth the price to get a competitor out of the way. Before deciding to purchase a trade-mark get advice on the particular case. So much depends on the circumstances in each case that it would not be safe to rely on general rules.

GIVING OTHERS THE RIGHT TO USE A TRADE-MARK

A trade-mark is not capable of ownership except in connection with a business and can not be given away or sold without a business to go with it. If it represents your business it can not at the same time represent the business of one or half dozen others. The reason is obvious. The purchasers, see-

ing the same trade-mark on similar goods made by different concerns, could not know whose goods it represents. One may make a good article, another an inferior one, and the way would be open to deception of purchasers. The purchasers must always be kept in mind, for the law is for their protection as well as the owner of the trade-mark. If you deceive or assist in deceiving purchasers, you lose your exclusive right to your trade-mark. Do not attempt to give others a right to use your trade-mark.

SLEEPING ON YOUR RIGHTS

Do not allow known infringers to go on, year after year, infringing your trade-mark, for after a time you lose your right to object. Many users of the same trade-mark may make it public property, then any one can use it. The star has been used so long, and for so many articles, and used by so many oil dealers, that it is public property for oil.

USING MANY TRADE-MARKS ON THE SAME ARTICLE

In certain lines of business many trade-marks are used for the same goods. A manufacturer of rolled oats may have a Blue Ribbon, Snow Flake, Sensation, Morning Glory and several other brands, but the oats are all alike, taken from the same bin. These brands may all be valid so long as he continues to so use them, but he can not sell them to others to be used by other persons on other kinds of oats.

STATE REGISTRATION

Nearly all of the states of the United States have trade-mark laws, and some of them afford very excellent protection, and in some respects, a state registration, so far as the business in that state is concerned, affords better protection than a federal registration. The state laws usually have criminal provisions against the imitation or copying of trade-marks registered in the state, and many of them provide that

the successful party may recover his attorney fees from the defendant, in addition to all damages which he has suffered, etc. This subject is worthy of investigation by a person who has a valuable trade-mark and is using it extensively. No attempt is here made to explain the effect of the laws of the several states, because each state has a different law. Be careful to not allow some one ignorant of the subject to file application for you, for an improper registration may destroy your trade-mark.

Contrary to what many believe, a registration in the U. S. Patent Office is only where the trade-mark is used in interstate commerce, or commerce with the Indian tribes or in foreign commerce, and a federal registration cannot be used as the basis of a suit when the infringer does business within a single state only. (See Warner vs. Seral, 191 U. S. 195). Under certain circumstances a state registration is highly desirable and to give some idea of the provisions of the state laws

a statement of some of the provisions of the acts of several of the states are here given. To register a trade-mark under a state law requires more experience and skill on the part of the attorney than a federal registration.

This is because the secretaries of states where the applications are filed, are usually not men skilled in this branch of the law, and they will accept an application in many instances even though grossly defective. One who is not familiar with the subject of trade-marks will not make a distinction between a trade-mark and label, or a form of advertising, and if a registration is trusted to unskilled persons, it is often a great detriment to the trade-mark owner rather than being of advantage to him. Below is a brief synopsis of the criminal and penal provisions of some of the state statutes:

ARKANSAS

The Arkansas Trade-Mark Law is substantially the same as the federal law, and requires a statement and

verified declaration for registration. A copy of the registration is *prima facie* evidence of ownership, and the right to exclusive use.

CRIMINAL LAW

The statute provides for a fine of not more than \$1,000, and imprisonment of not more than one year for infringement.

DAMAGES

The owner of a registered mark may collect damages under the common law, and any additional attorney's fees from the infringer.

CALIFORNIA

Any person who reproduces, copies or imitates, or counterfeits a trade-mark registered under the laws of this state, shall be guilty of a misdemeanor.

Every person who sells goods bearing a trade-mark, warrants the trade-mark to be genuine and lawfully used.

COLORADO

In case the plaintiff is successful in maintaining his action for damages or for permanent relief by injunction, or for nominal damages only, he shall be entitled to recover attorneys fees as a part of the cost.

CONNECTICUT

After registration, a trade-mark is in force as long as it is used. It may be assigned, and the assignment recorded. Registration is *prima facie* evidence of ownership. Infringers are liable for double damages, and for a sum of not more than \$500 in addition to such damages.

CRIMINAL LAW

A small fine may be imposed for infringing a registered trade-mark.

DELAWARE

Every person who shall use a counterfeit or imitation of any trade-mark, shall be guilty of a misdemeanor and

punished by imprisonment in the county jail for not less than three months or more than one year, or by a fine of not less than \$50 or more than \$100, or both.

A court may grant injunctions to enjoin the manufacture, use or display or sale of goods containing any counterfeit or imitation of another's trade-mark, and may award damages for such wrongful manufacture, such as the court may deem reasonable, and shall require the defendant to pay the complainant all profits derived from the wrongful manufacture or sale, and shall have all the counterfeits or imitations destroyed.

FLORIDA

Florida has a provision in its trade-mark law providing a fine of not more than \$500, and imprisonment of not more than three months for infringement. A certificate of registration is sufficient proof of adoption and use.

IDAHO

A certificate of registration is sufficient evidence of ownership of a trade-mark. A registrant may enjoin the use, or display for sale of goods bearing an infringing trade-mark. An infringer is liable for a fine of not more than \$100, and imprisonment of not more than three months.

ILLINOIS

The statute of Illinois provides that whoever counterfeits or imitates any trade-mark, etc., shall be fined not less than \$100 or more than \$200, or imprisoned not less than three months nor more than one year, or punished by both fine and imprisonment.

IOWA

Anyone who registers a trade-mark in Iowa can recover damages, attorney fees and profits, and is entitled to injunction against use of it by an infringer. The criminal law provides imprisonment of not more than thirty

days, and a fine of not less than \$25.00 or more than \$100.00 for imitating the trade-mark.

KANSAS

Provides that an infringer may be fined not more than \$100 or imprisoned not more than three months. Courts have jurisdiction to grant injunctions, to award damages for infringement, and give the plaintiff judgment for all profits made on sales bearing infringing marks.

LOUISIANA

An infringer of a trade-mark registered in Louisiana is liable for all profits made from the wrongful manufacture or sale of goods bearing an infringing trade-mark, and the court may order all counterfeit labels destroyed. The criminal law provides for a fine of not more than \$100, and imprisonment of not more than three months, for counterfeiting or imitating a trade-mark.

MAINE

Certificate of registration is *prima facie* evidence of the right of the owner thereof to the exclusive use of the trade-mark therein described. One who copies or imitates a recorded trade-mark is liable to the owner for double damages and in addition a sum not exceeding \$500.

One who fraudulently affixes any similar trade-mark to goods may be fined not more than \$500 or imprisoned not more than thirty days.

MARYLAND

A certificate of registration is sufficient evidence of the recording of the trade-mark, and of the existence of the person named in the certificate. The Supreme Court and Superior Court have jurisdiction to restrain the manufacture or sale of counterfeits or imitations. The criminal law provides a fine of not more than \$200, and imprisonment of not more than a year, or both. The law applies to everyone who sells or exposes for sale the goods bearing an infringing trade-mark.

MASSACHUSETTS

Registration in Massachusetts is sufficient proof of adoption and use. The owner of a registered trade-mark may enjoin the manufacture, use or display for sale of goods bearing a counterfeit or imitation of his trade-mark. The court shall grant an injunction restraining the manufacture, use or display for sale of goods bearing counterfeit of a registered trade-mark. The registrant may recover damages to any amount the court may deem reasonable, and profits from the wrongful manufacture and compel the infringer to surrender all imitations or counterfeits. The criminal law provides a fine of not more than \$200, and imprisonment of not more than one year for infringement.

MICHIGAN

Any person who sells or keeps in his possession for sale any goods bearing a counterfeit or imitation of another's trade-mark shall be guilty of a misdemeanor, punished by a fine of not

less than \$10 or more than \$100 or by imprisonment in the county jail not more than 90 days, or both fine and imprisonment.

MINNESOTA

The Minnesota law provides a penalty of a fine of not more than \$100 or imprisonment of not more than three months, for the imitating or counterfeiting of another's trade-mark; and for fraudulent imitation, it provides for imprisonment in the county jail of not less than six months and not more than twelve months, and a fine of not more than \$5,000. The owner of a registered trade-mark may sue to enjoin the manufacture, use or sale of counterfeits or imitations, and the court may grant injunctions restraining the manufacture, use, sale or display for sale, on such terms as the court may deem reasonable. The owner of a registered trade-mark may recover all profits made from the wrongful manufacture, use or sale of goods bearing

an imitation trade-mark, and the court may order all counterfeits or imitations destroyed.

MISSOURI

For counterfeiting trade-marks a penalty is provided of imprisonment in county jail not less than three months nor more than twelve months, and a fine of not less than \$100, nor more than \$500, or both fine and imprisonment, and where an intent to defraud is shown imprisonment for not less than one month nor more than twelve months, and a fine of not less than \$100 nor more than \$5,000; or both fine and imprisonment. In a civil suit, the court has power to enjoin the further use of the labels or trade-marks, and order the destruction of all on hand, etc.

MONTANA

Any person who imitates any label or trade-mark or form of advertisement, shall be guilty of a misdemeanor.

NEBRASKA

Any person who falsely makes or counterfeits any trade-mark with an intent to damage or defraud any person, shall be liable to imprisonment in the penitentiary for not exceeding twenty years, nor less than one year, and pay a fine not exceeding \$500.

NEVADA

Any person who imitates or copies a registered trade-mark may be fined not less than \$25 nor more than \$500, or imprisoned not less than five days or more than thirty days, or both fine and imprisonment and shall be liable to any person injured for all damages incurred. A trade-mark is entitled to the same protection in the courts of this state as any other personal property, and the court may issue injunction to prevent infringements.

NEW HAMPSHIRE

The New Hampshire trade-mark law applies to manufacturers, provides for

issuing injunctions to enjoin the manufacture or sale of articles bearing a counterfeit or imitation trade-mark, ordering the destruction of all imitation labels, etc. Violations of the act may be punished by imprisonment in the county jail not less than three months or more than one year, or by fine of not less than \$100 or more than \$200 or both.

NEW JERSEY

Injunction may be granted enjoining the use of any copy or imitation or counterfeit trade-mark, and the court may render judgment for all damages arising from its unlawful use, together with all costs and expenses in prosecuting the action, order the offending labels destroyed and in addition to this, the owner of a trade-mark may recover from \$200 to \$500 as a penalty for the wrongful use.

NEW YORK

Any person who affixes to any article of merchandise any imitation of the

trade-mark of another, is guilty of a misdemeanor.

NORTH CAROLINA

A trade-mark registered under the laws of this state is declared to be entitled to be fully protected as the property of the registrant. A certificate of registration is sufficient proof of adoption. The certificate cannot be assigned and when the trade-mark is sold, it must be registered by the purchaser. A court is empowered to enjoin manufacturers from using counterfeit trade-marks or using imitation labels as trade-marks. It shall enjoin the manufacture or sale of such goods bearing such trade-marks or offering the same for sale, and may make such other orders as to the court may seem necessary. It may require the defendant to pay all damages incurred, with all costs, pay all profits obtained which are derived from the wrongful use, or both profits and damages, and to surrender all counterfeits or imitation labels.

Any person who violates the provisions of the act are subject to a penalty of \$200 to be recovered by the one who registered the trade-mark, etc.

NORTH DAKOTA

One who sells an article bearing a trade-mark warrants it to be lawfully used. Anyone who uses a trade-mark that he was not the first to employ or use is guilty of a misdemeanor and in addition liable to the injured party for damages to the sum of \$100 for each offense.

OHIO

The Ohio trade-mark law is so defective as not to be of any substantial use, but it is probable that it will be amended at the present session of the legislature.

OKLAHOMA

The laws of Oklahoma provide for a fine of not more than \$100, or imprisonment of not more than three

months, for infringement of a trade-mark. Courts may grant injunctions to prevent the manufacture or sale of goods bearing the trade-mark, award complainant damages for wrongful use, together with all profits from sales, and order the destruction of all labels or counterfeits.

OREGON

Anyone who infringes a recorded trade-mark forfeits to the owner of the trade-mark one-half of the goods on which the infringing mark is placed or the value thereof, to be recovered in an action in any court having jurisdiction. For a second infringement, he forfeits the whole value of the goods on which it is used.

Goods imported into this state which shall bear for the purpose of deception any trade-mark similar to registered trade-mark used on the same goods, shall forfeit the goods imported to any party injured thereby.

PENNSYLVANIA

Pennsylvania has a general trade-mark law providing for registration, but the remedies provided for infringement are those of the common law in force generally.

RHODE ISLAND

One who infringes a trade-mark registered under the state law of Rhode Island is liable to a fine of not more than \$100 or imprisonment for not more than three months. An injunction against all infringing marks may be granted, reasonable damages be awarded, together with all profits derived from the sale of goods containing infringing labels, and the labels ordered destroyed.

SOUTH CAROLINA

One who uses an unrecorded trade-mark which infringes one recorded in this state, is liable to a fine of not more than \$100 or imprisonment for not more than three months. The court

may grant injunction to restrain the manufacture or sale of goods bearing the infringing mark, may award reasonable damages, together with all profits derived from such sales and order the destruction of all infringing labels.

SOUTH DAKOTA

Anyone who sells an article bearing a trade-mark, thereby warrants the trade-mark to be lawfully used. Anyone who keeps for sale an article bearing a counterfeit trade-mark knowing the same to be a counterfeit, is guilty of a misdemeanor.

TENNESSEE

Counterfeiting a trade-mark or selling goods bearing an imitation of another's trade-mark registered in this state, is punishable by a fine of not more than \$100 or imprisonment not more than three months. Courts may grant injunctions against infringements, award damages for wrongful

use, give the plaintiff all profits made under wrongful sale, and order the destruction of all counterfeit or imitation labels. One who uses another's trade-mark for the purpose of defrauding him, may be punished by imprisonment or by a fine of not more than \$100.

TEXAS

Infringement may be punished by a fine of not less than \$25, or more than \$100. Each day's violation is a separate offense. The courts may enjoin the wrongful manufacture or sale of goods bearing another's trade-mark and grant reasonable damages for wrongful use.

Note.—There is serious danger of losing your trade-mark rights in Texas if you do not register there, especially if some other person registers your trade-mark.

UTAH

The courts may grant injunctions against the use of infringing trade-marks and award damages for wrong-

ful use of the same. Forging or counterfeiting trade-marks is made a misdemeanor and is punished as other misdemeanors.

VERMONT

One who knowingly infringes a trademark registered in this state may be fined not exceeding \$1,000, or imprisoned not exceeding one year. All courts having jurisdiction may enjoin the manufacture or sale of goods bearing an infringing mark, award reasonable damages for wrongful use, may order the defendant to pay the plaintiff a sum equal to the amount which he would have received for the same quality of genuine goods, and may order any similar labels destroyed.

VIRGINIA

One who uses an infringing trademark is guilty of misdemeanor and shall be punished by imprisonment of not more than three months, or fined not more than \$100.

WASHINGTON

Provides a fine of not more than \$100 and imprisonment not more than three months, for infringement. Courts may grant injunctions to prevent the sale of goods bearing an infringing trade-mark, award damages for the wrongful use, and all profits made from the sale of goods bearing such infringing mark, and order all such labels destroyed.

WEST VIRGINIA

Provides a fine of not more than \$300 and imprisonment not more than three months, or both fine and imprisonment of one guilty of infringing a registered trade-mark. It also provides that all trade-marks shall be registered in that state.

WISCONSIN

Provides that an infringer may be fined not more than \$200 or imprisoned not more than six months. Courts may grant injunctions restrain-

ing infringement of a trade-mark and award damages to the injured party which he may suffer from such infringement.

WYOMING

Provides that an infringer may be fined not more than \$200 or imprisoned not more than one year. Courts may grant injunctions to prevent infringements, award damages for the wrongful use of a trade-mark as well as render judgment for profits on wrongful sales, and it may order all infringing labels destroyed.

PRIVATE REGISTRATION BUREAUS

A private registration bureau confined to a single industry, if constructed by a thoroughly capable person and includes all trade-marks in that industry, is of tremendous value as a source of information for those who are permitted to have access to it.

Things Worth Knowing

What is an interference?

Answer:—It is a term used by the Patent Office and means what the word implies, that something is in the way, an obstruction and the thing that is in the way is another trade-mark similar to your trade-mark. If your trade-mark is registered in the Patent Office and someone applies to register the same or similar trade-mark, the examiner looks over the registered marks, finds your trade-mark was registered on a certain date, and if the applicant claims he used the trade-mark before you registered it, the examiner then declares an interference and notifies you; then testimony is taken by both parties to prove who first used it. If two parties apply at the same time to register the same trade-mark, the examiner also declares an interference and then the one who can prove first use is allowed to register.

What is an opposition?

Answer:—If you discover that someone is trying to register your trade-mark, or one similar to it, you are allowed to oppose it if you file your notice of opposition within thirty days after the trade-mark is published in the Official Gazette. This does not mean that you can write to the Commissioner of Patents and tell him you object, but requires very carefully drawn pleadings by one skilled in this practice and is almost as difficult to properly prepare as a bill in equity to be filed in the United States District Court. An opposition may be because the opposer owns the trade-mark, or because some third party owns it, or because nobody owns it, or because it belongs to anyone who wishes to use it, or any reason which will show that the party who tries to register it does not own it.

What is meant by cancellation?

Answer:—If you find some one has registered your trade-mark you can file

a petition to cancel the registration. This is also a technical pleading and requires skill and care in preparation of the petition and prosecution of the case. It is preferable to filing opposition, because you can have more time to prepare for the attack.

Does registration keep others from using the registered trade-mark?

Answer:—No, but it furnishes you a basis for a suit against an infringer, gives you remedies for the infringement you would not have if the trade-mark was not registered, and if copies are filed in the custom houses, prevents foreign goods from being shipped in with any similar trade-mark attached. It automatically prevents many infringements and law suits, because few will try to appropriate a registered trade-mark. It extends the territorial power of courts in enforcing injunctions and when properly used, affords, the registrant a liberal reward for his trouble or expense in registering.

NOTICE OF REGISTRATION

Every owner of a registered trade-mark should place on his package near his trade-mark this: "Reg. U. S. Pat. Off." or "Registered in U. S. Patent Office." This is required by Sec. 28, of the act of 1905.

How do you adopt a trade-mark?

Answer:—By selecting some mark not already in use for the same goods, by applying the mark to some article of commerce and by selling the article with the mark upon it. Using the mark in advertisements only does not make it a trade-mark.

Who may own a trade-mark?

Answer:—One who manufactures or one who selects and sells the goods. The goods may contain the trade-mark of the manufacturer and also the one who selects the goods.

What kind of a label can be copyrighted?

Answer:—One which has such artistic merit that it is useful for other

purposes than merely for the purpose of putting it on containers of goods to indicate the contents of the package; things are copyrighted with a view to giving the author exclusive right to make and sell the copies. Many labels are permitted to be copyrighted, which in my opinion are not proper subjects for copyright and are worthless.

A photograph of a building may be copyrighted, and then a dozen other persons may photograph the same building and each one can be copyrighted. It is easy to see that a copyright of a thing of this nature would be of no particular value for use in attaching it to the goods. The theory of the copyright is that the owner of it will sell the copies; the theory of business is that the copyright is useful in ornamenting the package. It is often a difficult question to determine whether an article submitted for inspection is a proper subject for a copyright. Many label copyrights are obtained which are entirely worthless.

Is it proper to speak of trade-marking as label?

Answer:—No. Some labels can be copyrighted, as is elsewhere explained. There is a great difference between a copyright and a trade-mark.

Is it proper to speak of getting a patent on a trade-mark?

Answer:—No. You register a trade-mark but there is no analogy between a patent and a registered trade-mark.

What is the difference between a suit for unfair competition and a suit for infringement of a trade-mark?

Answer:—A suit for unfair competition is one in which you set up facts showing that your competitor is trying to defraud you by various plans and schemes, for selling his goods and making the public believe that they are your goods, or the same as your goods. This plan may be by using a trade-mark exactly like your trade-mark, or similar to your trade-mark, or by dressing his goods in a package to look like your

package, and by this means cause the public to buy his goods, believing they are buying your goods; or any other plan which he may adopt, that will accomplish the same purpose. A suit for unfair competition is based on fraud and in a suit for infringement of trade-mark, the defendant may not be guilty of intentional fraud—he may not know that you own the trade-mark and may not have had any intention to sell his goods for your goods, but it matters not what his intention was, you have a right to enjoin his use of your trade-mark. In other words, unfair competition is bad faith on the part of the defendant, and in a trade-mark case, even if he is acting in good faith, he will be prevented from infringing because he is trespassing on your property right.

What is the difference between a state registration and a registration in the United States Patent Office?

Answer:—If you have a trade-mark registered in the United States Patent Office, you can use the certificate of

registration as evidence in a suit, provided the party you are suing, uses the same or similar trade-mark in inter-state or foreign commerce, or commerce with the Indian tribes, but if the party you desire to sue, does not use the trade-mark, except in a single state, you could not use your patent office registration as a basis for the suit. In a case of this kind a registration under the state law, would be much more useful, than a registration in the patent office.

What is the difference between a print and a label?

Answer:—A label must be used on the goods, and a print is something which need not be used on the goods but is usually used in advertising the goods.

A great many prints are filed in the patent office and copyrighted.

What is the difference between a copyright and a trade-mark?

Answer:—A copyright is the exclusive right to make copies. A trade-mark is the exclusive right to the use

of something for the purpose of attaching it to the goods to indicate who made or selected the goods. There are many and various kinds of things that may be copyrighted if the original copies contain the proper notice of copyright which notice must be strictly as directed by the statutes; any other notice would be void.

What is a proper notice of copyright?

Answer:—That depends on what is to be copyrighted. There are so many different kinds of notice that it is advisable to make inquiry of an attorney respecting the particular thing to be copyrighted and how the notice should be placed.

What is the difference between a trade-mark and a label?

Answer:—A label is something which is put on a container of goods to show what is in the container. The trade-mark is something put on the container or on the goods to show who made the goods or who selected and controlled

the making of the goods. They are opposite, one to the other. A label is necessarily descriptive of the goods; a trade-mark is not necessarily descriptive of the goods.

In trade, by the term "Label" is usually meant a printed or lithographed paper prepared for pasting to cans and boxes, and usually contains a statement of the contents of the package, some times a trade-mark, and various other features of ornamentation. It is incorrect to speak of trade marking a label. A label such as here mentioned, may contain a trade-mark, but it would not be a trade-mark. Protection for such labels is usually best secured through recourse to the law of unfair competition, but some of them may be copyrighted, although that does not afford very substantial benefits.

You have stated what may not be proper trade-marks, now what are the things which may be properly used?

Answer:—Examine the don't column and then select from anything there is

remaining. To know what is proper to use you must know what is not proper to use. Make your selection and then see whether it is any of the things which may not become a trade-mark for, that kind of goods. If you find any of the objections to it under the different heads we have been discussing, discard it and select another until you get one to which there is no legal objection. Some business men think the field is very limited. That is a mistake. The field is as broad as imagination. Millions of symbols and names of things may be used. All the different kinds of birds, the flowers, trees, rocks, plants, animals, insects, geometrical figures, landscape scenes, buildings, the names of the stars and planets, fanciful pictures of persons, cartoons; and the dictionaries and encyclopedias will bewilder you with names which would be proper and technical trade-marks. It is a great deal of work to get one that is attractive, but it is mostly a question of industry and imagination. when you find one suitable, submit it

to your attorney for such investigation as he can make as I have elsewhere indicated.

PRESERVING YOUR EVIDENCE

A file of evidence applying to each trade-mark should be kept and as near as possible should contain a few of the original labels or packages; the name and address of the person who made the drawing for the trade-mark; the name and address of the person who made the cut from which the first labels were printed which contained the trade-mark, the date when it was made; a copy of the order for the printing of the labels or other means of producing the trade-mark; the invoice for the labels, the bill for printing, receipt for payment; the name and address of the first purchaser of the goods; the original order for the goods, with date of shipment and numerous orders from different purchasers, say eight or ten of the earliest, so that if one dies or goes

out of business, others may be had as witnesses. The names and addresses of parties in your employ who had personal knowledge of the first use of the trade-mark; a few original letters ordering the goods; advertising cards or the date of publications of advertisements in one or more papers, if there were any; about one original order for each month of each year (if there were orders each month, if not then at longer intervals) a copy of the invoice, and the original shipping receipt. If the ownership of the business changes, then these records should be delivered to the successor in business who will continue to keep the record.

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